

Response

Applicants, through their attorney, respectfully request the Examiner to consider the application in view of the included amendments and remarks. These amendments include those in Applicants' response and amendment after final rejection, dated September 1, 2009, which was not entered.

Support

Applicants have amended claim 1 to specify that the functional fluid of the present invention is selected from the group consisting of transmission fluids, hydraulic fluids, transformer fluids, fuels, diesel, gasoline, biofuels, and mixtures thereof. Support for this amendment is found on page 6, lines 3-8 of the specification.

Applicants have cancelled claim 22.

Applicants have added new claims 23 and 24. Claim 23 specifies a method identical to claim 1 except that the functional fluids include engine oils, greases, gear oils and transmission fluids, while the indicator is selected from a list of specific indicators. Support for this claim is found in claim 9, as well as on page 10, lines 17-25 and page 11, lines 11-15 of the specification. Claim 24 specifies the indicators of the present invention consist of methylene blue, alizarin, or combinations thereof. Support for this claim is found in the passages of the specification reference above.

No other elements of the claims have been changed.

Remarks

The Examiner rejected claims 1-14 under 35 U.S.C. 102(b) as being anticipated by Becket (US 5,710,372). Applicants respectfully disagree.

Applicants continue to disagree that the teachings of Becket, directed toward aqueous machining fluids, can be applied to the clearly organic functional fluids of the present invention. However, Applicants acknowledge that the Examiner has not been persuaded by Applicants arguments. In the interest of advancing this case, Applicants have made the amendments described above.

The Examiner states, at the top of page 3 of the current office action, that the machining fluids of Becket have been read on the claimed engine oil, greases, gear oils and farm tractor fluids. The Examiner did not list transmission fluids, hydraulic fluids, transformer fluids, fuels, diesel, gasoline, and biofuels. Therefore, the Examiner has indicated that Becket does not read on these fluid types. Applicants have amended claim 1 to

specify only this list of fluids, leaving the engine oil, greases, gear oils and farm tractor fluids, that the Examiner finds in Becket, out of the claimed list.

Applicants respectfully submit that the present claims specify functional fluids which the Examiner has indicated are not read on by Becket. Therefore the present claims are novel over Becket and the rejection should be removed.

The Examiner rejected claim 22 under 103(a) as obvious over Becket in view of either Pickup (US 3580704) or Mliner (US 4654309). Applicants have cancelled this claim making the rejection moot.

Applicants have added new claims 23 and 24. These new claims include the functional fluids the Examiner has indicated are read on by the aqueous machining fluids of Becket. However, claim 23 specifies that its indicator is selected from a list consisting of redox indicators and alizarin. Claim 24 further specifies that the indicator used in the claims methods is methylene blue, alizarin, or a combination thereof.

Applicants respectfully submit that neither Becket, nor Pickup, nor Mliner teach any of the specified indicators of the present invention. Therefore the new claims should be found to be both novel and nonobvious over the references.

Applicants note that Becket teaches a reagent and a color indicator (see the Abstract of Becket). Becket provides more details of its reagents in column 9, lines 1-25 of the reference, but none of the indicators of claim 23 are included in Becket. In addition, Becket's color indicator is described in greater detail in column 10, lines 8-23 of the reference. None of these color indicators are included in the redox indicators of the present invention. Pickup and Mliner use acid/base indicators such as bromophenol blue and m-cresol purple, which are not a redox indicator (see col 3, line 12 to col 4, line 8 of Pickup and col 5 lines 5-11 of). Furthermore, none of the indicators of claim 23 are included in either Pickup or Mliner. Therefore, Applicants respectfully submit that the new claims are both novel and nonobvious over the references.

In the advisory action dated September 8, 2009, the Examiner indicates that the amendments included in the previous response, as well as this application, would not put the application in condition for allowance but rather would convert the current 102 rejections

based on Becket to 103 rejections based on the Becket. The Examiner states that the motivation for the rejection would be that it would be obvious to try the method/apparatus of Beck on similar fluids such as those claimed.

Applicants point out that this does not meet the requirements for a prima facie obviousness rejection, as the Examiner has provided no reference or source that discloses specific features of the present claims, namely the specific types of fluids required. By the Examiner's own previous statements in the office actions to date, Becket provides no teachings of the currently claimed fluids, thus a statement that it would have been obvious to try the methods of Becket on similar fluids is by definition a mere conclusory statement and insufficient for a proper obviousness rejection. The Examiner has not cited any other reference which may be properly combined with Becket that discloses the claimed fluids. With regards to the new claims in the application, the Examiner has cited no reference that teaches the markers required by the claims. For these reasons, Applicants submit that 103 rejections the Examiner implies, based solely on the current references, would be improper.

Conclusion

For the foregoing reasons it is submitted that the present claims are novel and unobvious over the cited reference, and in condition for allowance. The foregoing remarks are believed to be a full and complete response to the outstanding office action. Therefore an early and favorable reconsideration is respectfully requested. If the Examiner believes that only minor issues remain to be resolved, a telephone call to the Undersigned is suggested.

Any required fees or any deficiency or overpayment in fees should be charged or credited to deposit account 12-2275 (The Lubrizol Corporation).

Respectfully submitted,
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